REMARKS/ARGUMENTS

Claims 1-2, 4-12, 14-47, and 49-100 are pending in this application.

Claim Rejections -35 U.S.C. § 112

Claim 95 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 95 has been amended to more particularly point out the subject matter which Applicant regards as the invention.

Claim Rejections – 35 U.S.C. § 102

Claims 1-12, 28-29, 43-57, 73-74, and 88-90 are rejected under 35 U.S.C. § 102(a) as being anticipated by Sugimoto ("Sugimoto", U.S. Patent No. 5,847,697).

Applicant respectfully traverses. However, Claims 3, 11 and 48 have been cancelled. Applicant respectfully submits that a *prima facie* case of anticipation has not been established for amended independent Claims 1 and 46. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits Claims 1 and 46 include elements that have not been disclosed, taught or suggested by Sugimoto. Regarding rejection of Claims 1 and 46, the Patent office relies on Sugimoto for the teaching of "detect[ing] duplicate entries", citing Sugimoto, column 20, lines 21-22. The text from Sugimoto cited by the Patent Office discloses: "A purpose of this routine is to detect duplicate entries in the SH.sub.-- DICT dictionary 108 and to record them for processing by the PROC.sub.--

MULT routine 193."(emphasis added) Applicant respectfully submits that the cited passage of Sugimoto merely involves a program routine that performs a look up to a database to see if a duplicated entry exists in the database. (See Column 20, lines 24-45 of Sugimoto) Thus, "detect[ing] duplicate entries" in Sugimoto is not equivalent to "detecting an activator event" as recited in Claim 1 and 46.

Additionally, Claims 1 and 46 recite the step of "detecting an activator event in the input text based upon a context of the input text, said activator including actuation of a predetermined key of a keyboard."(emphasis added) Generally, Sugimoto teaches a character generator for a keyboard for operation by fingers of a single hand of a person. Each key is assigned a character and each of at least some of the keys are multiple-character keys assigned multiple characters. The character generator generates one of the characters assigned to each of a sequence of character keys that are entered on the keyboard. Based on the sequence of character keys that have been entered, the resolution is made as to the correct character for any of the multiple-character keys in the sequence of keys that are entered. (See Abstract, Column 2, lines 47-50 of Sugimoto)

Applicant respectfully submit that Sugimoto merely teaches "a character generator" which generates the correct character using various dictionary databases since one character key on the keyboard represents more than one character depending on its position in a sequence of character keys. In contrast, Claims 1 and 46 specify steps of detecting an activator event which may be triggered by inputted predetermined keys (such as an apostrophe character) and determining whether the predetermined keys are part of a word based upon a "context" of the word.

Under *Lindemann*, a *prima facie* case of anticipation has not been established since Sugimoto fails to teach, disclose or suggest the element of "means for detecting an activator event in the input text based upon a context of the input text, said activator including actuation of a predetermined key of a keyboard" as recited in amended independent Claims 1 and 46.

Accordingly, removal of the pending rejection to Claims 1 and 46 under 35 U.S.C. §102 is respectfully requested. Claims 1-12, 28-29, and 43-45 depend on Claim 1 and Claims 47-57, 73-74, and 88-90 depend on Claim 46. Claims 1-12, 28-29, 43-45, 47-

57, 73-74, and 88-90 are therefore believed to be allowable due to their dependency on allowable base claims.

Claim Rejections – 35 U.S.C. § 103

The Patent Office rejected claims 13-27, 30-42, 58-72, and 75-87 under 35 U.S.C 103(a) as being unpatantable over Sugimoto as applied in independent claim 1, in view of Takehara et al. ("Takehara", EP0588538). Claims 91- 100 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugimoto in view of Takehara.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Further, "to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claims 13-27, 30-42, 58-72, and 75-87 stand rejected under 35 U.S.C. §103(a). Applicant respectfully traverses. As indicated in the foregoing *Claim Rejections – 35 USC § 102* section, the primary reference, Sugimoto fails to teach, suggest or disclose all the elements recited in Claims 1 and 46. Accordingly, Claims 1 and 46 are nonobvious under 35 U.S.C. § 103. Claims 13-27 and 30-42 depend on Claim 1. Claims 58-72 and 75-87 depend on Claim 42. Claims 13-27, 30-42, 58-72, and 75-87 are therefore nonobvious due to their dependences. Withdrawal of all rejections is requested.

Claims 91-100 stand rejected under 35 U.S.C. §103(a). As noted by the Patent Office, Sugimoto fails to teach of the elements of "means for initiating <u>an input method editor loop</u> in response to said detecting means detecting an apostrophe in the input text; and means for modifying a word in the input text based upon a word modification contained in the <u>input editor loop</u>," as recited in Claim 91. (emphasis added)(Office Action, Page 22, lines 18-23) The auxiliary reference, Takehara, does not make up for this defect in Sugimoto. Takehara merely teaches an information processing system which allows a user to input first language and second language using a first language keyboard. The system displays characters of second language in response to operation of <u>conversion</u> key in order for the user to input the second language.

In formulating the rejection in Claim 91, the Examiner states that Takehara teaches the above noted defects in Sugimoto, citing Column 10, lines 31-33 of Takehara which reads, "... the character has a corresponding character of another language. Then at step S2, the input buffer 101 for characters built in the interface LSI 95 is cleared." The cited passage of Takehara is a part of the steps of checking whether "a conversion flag" has "FALSE" value or "TRUE" value, and clearing "the input buffer" designed for storing data corresponding to characters to be displayed. (See Column 10, lines 26-35) Therefore, the cited passage fails to teach the elements of "means for initiating <u>an input method editor loop</u> in response to said detecting means detecting an apostrophe in the input text; and means for modifying a word in the input text based upon a word modification contained in the <u>input editor loop</u>," as recited in Claim 91.

Instead, Applicant finds that a passage in Column 11, lines 50-53 of Takehara discloses "characters are arranged substantially in a loop, and accordingly, they can be selected in a circulating manner by successive manual operation of the character conversion key 25," as quoted by the Examiner. Applicant respectfully submits that the passage of Takehara also fail to teach, suggest, or disclose the element of "modifying a word in the input text based upon a word modification contained in the <u>input editor loop</u>."(emphasis added) Takehara merely teaches the method that allows a user to select a character by manner by successive <u>manual operation</u> of the character <u>conversion key</u>. In other word, the user needs to manually select correct characters (of

the second language) stored in the input buffer in order to input characters of the second language which are not supported by the first language keyboard. For example, the alphabet character e in English and corresponding characters in other languages (è é ê ë) are stored in the input buffer. When the user inputs a character e via the English keyboard and presses the conversion key, each of the corresponding character (è é ê ë) will be displayed one by one. In contrast, Claim 91 specifies "input editor loop" contains a correct word format for the given inputted string of characters when the system detects an apostrophe key inputted by the user.

Thus, Takehara, either alone or in combination with Sugimoto, fails to teach or suggest the element of "means for initiating an input method editor loop in response to said detecting means detecting an apostrophe in the input text; and means for modifying a word in the input text based upon a word modification contained in the input editor loop." Further, there exists no reason, suggestion, or motivation from the prior art for modifying the teachings of Sugimoto and Takehara to achieve Applicant's invention.

Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness of Claim 91 has not been established. Claims 92-100 are believed to be allowable based on their dependence upon Claim 91. Withdrawal of all rejections under 35 U.S.C. § 103 is requested.
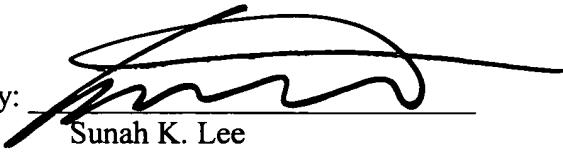
CONCLUSION

In light of the foregoing amendments and remarks, Applicant respectfully requests a timely Notice of Allowance.

Respectfully submitted,

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